

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

## **II. REMARKS/ARGUMENTS**

### **A. Summary of the Amendments**

Claims 163, 167, 199 and 216 have been amended to clarify the subject matter being claimed. The applicant submits that the amendments have not been made to overcome the art cited by the examiner.

Claims 156, 157, 173-179, 184, 188 and 189 were previously cancelled without prejudice.

The remaining claims are unchanged.

The applicant submits that the amendments introduce no new matter.

### **B. General Comments**

In his response to arguments, the Examiner indicated that, although all independent claims are directed to a "spa control system", he was treating the system as a generic control system for downloading software components from a remote computer to an individual controller through an interface signal converter. In support for his position, the Examiner indicated that there were no claim elements in the independent claims that set forth the control of the spa.

The Applicant respectfully disagrees with the Examiner's position. In accordance with the MPEP section 2131, "A claim is anticipated only *if each and every element as set forth in the claim is found*, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The expression "spa control system" is not a mere statements of intended use but rather is a statement of the intentional purpose in which the system must be used. The applicant submits

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

that the expression "spa control system" is necessary to give meaning to the claims. It is noted that "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). In addition, the applicant submits that the preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966. The applicant submits that the preamble expression "spa control system" imparts structural limitations to the claim in that the control system must be such that is a spa control system.

Moreover, the Applicant would like to bring to the attention of the Examiner that the independent claims include feature which are specific to a spa control system. More specifically, independent claims 155, 187, 195 and 200 include a "spa controller" as an element of the claims and independent claim 186 includes "spa controller means" as an element of the claim. With respect to independent claim 216, this claim includes the step of "establishing a communications link with a spa controller". As such, the applicant submits that the Examiner cannot simply dismiss this feature from the claims.

In light of the above the Applicant submits that the Examiner's interpretation of a "spa control system" as a "generic control system" is not appropriate.

### **C. Claim Objection**

The Examiner objected to claim 163 indicating that it should be dependent upon claim 162 instead of claim 155 in order to provide proper antecedent bases of the term "said at least two

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

different types". In response to the Examiner's objection, the Applicant has amended claim 163 so that it is now dependent upon claim 162.

The Examiner also objected to claim 216 as being confusing in the manner the preamble was written. The Applicant submits that it is permitted to include in the preamble of a claim information on the context in which the claimed invention can or will be used. As such, the inclusion of a memory unit and a processor in the preamble of a computer readable storage medium claim is appropriate to show context. However, in response to the Examiner's comments, the Applicant has rewritten the claim to make its presentation clearer and to clarify any possible ambiguity as to the claimed subject matter. The applicant submits that claim 216 is clear.

#### **D. Claim Rejection under 35 USC §112**

In the Office Action, the Examiner has rejected claims 155, 158-172, 180-183, 185-187, and 190-219 under 35 U.S.C. §112 as failing to comply with the written description requirement. More specifically, the Examiner indicated that he was of the view that the claims contained subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The Applicant respectfully disagrees with the Examiner for the reasons presented herein below.

#### **Claims 155, 186, 200 and 216**

With respect to independent claims 155, 186, 200 and 216, the Examiner indicates that there is a lack of support in the original disclosure for "receiving communication signal conveying software components over the communication link, said software components comprising updates to software already installed on said spa controller".

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

The Applicant submits that the above-described feature is supported by the specification as originally filed. More specifically, support for this feature can be found on p. 9 lines 7-9, in figure 8 as well as in former claim 29 of the application as originally filed. The Applicant submits that the subject matter of former claim 29 is part of the specification as originally filed since it was part of the application at the time of filing.

P. 9 lines 7-9 read as follows:

"In block 152, the dealer can monitor the current software installed on spa controller 53. If there is a software update, the dealer can download this info by clicking button 153."

In figure 8, button 153 reads: "SEND NEW SOFTWARE TO SPA".

And former claim 29 as originally filed reads as follows:

"The spa of claim 1, wherein said remote computer is used to download software to said spa controller".

In the Office Action, the Examiner indicates that "this info" on page 9 is "a vague term that could mean downloading the information as to whether there IS an update to the spa controller or downloading the software version number. While it is possible that the downloading of a software component through the communication link to the spa was the intended purpose of these statements in the specification, it is certainly not clear." The applicant is of the view that the term "this info" refers to the term "a software update" and that therefore the sentence means "the dealer can download this [software update] by clicking button 153". Therefore, the applicant submits that the intent of the term "this info" is clear. However, the applicant would like to indicate that, if there is any ambiguity in the statement on p.9 as to the intent of the term "this info", that ambiguity is removed by the caption on button 153 of figure 8 which reads: "SEND NEW SOFTWARE TO SPA". Clearly, the purpose of button 153 is to send the software to the spa. If the Examiner is still of the view of that an ambiguity subsists, then the content of former

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

claim 29 which states that the remote computer is used to download software to the spa controller makes it clear that software is downloaded to the spa controller from a remote computer.

In light of the above, the applicant submits that the claims contain only subject matter which was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

As such, the applicant submits that claims 155, 186, 200 and 216 satisfy the requirements of 35 U.S.C. §112 with regard to the written description requirement. The Applicant requests that the Examiner withdraw his rejections under 35 U.S.C. §112 with regard to claims 155, 186, 200 and 216.

Claim 167

With respect to independent claim 167, the Examiner objects to the use of the phrase "said spa controller includes a body" and the interface signal converter is integrated into the body of the spa. In support for his position, the examiner indicates that the language of claim 167 is not used in any way in the specification. The Applicant is of the view that the above described feature is inherently described in the specification as originally filed. However, in the interest of moving matters forward, the Applicant has amended claim 167, which now reads as follows.

Claim 167. The spa control system as in Claim 155, wherein said interface signal converter is rigidly attached to the spa controller as one unit.

Support for amended claim 167 can be found in the specification as originally filed on p. 12 lines 9-10. In light of the above, the Applicant requests that the Examiner withdraw his rejections under 35 U.S.C. §112 with regard to claim 167.

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

Claims 187 and 190-194

With respect to independent claims 187 and 190-194, the Examiner indicates that there is a lack of support in the original disclosure for "receiving data comprising a record of errors from said spa controller". In support for his position, the examiner indicates that page 9 of the specification shows the dealer having the ability to monitor errors and to view the number of times an error has occurred. The Examiner however indicates that there is no showing of the actual data transfer of a "record of errors" as claimed. He indicates that the errors are transferred, but could be transferred one by one on a real-time basis or in any number of different ways. The applicant respectfully disagrees. The Applicant directs the Examiner's attention to p. 10 lines 3-6 which read as follows:

"Then, utilizing IR transceiver 52A with portable computer 52, the service technician is able to download from spa controller 53 to portable user computer 52 data that includes a **record of errors** that may have occurred during the operational life of the spa, as shown in FIG. 3B."

As such, the applicant submits that there is showing of the actual transfer of a "record of errors" and respectfully requests that the Examiner withdraw his rejection of claim claims 187 and 190-194 under 35 U.S.C. §112.

Claims 155, 158-172, 180-183, 185, 186 and 195-219

With respect to independent claims 155, 158-172, 180-183, 185, 186 and 195-219, the Examiner rejected these claims as failing to satisfy the enablement requirement of 35 U.S.C. §112 first paragraph. More specifically, the Examiner indicates that the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In support for his position, the Examiner refers to his previously presented argument regarding the written description requirement and indicates that: "As noted above, the specification is vague

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

with regard to the downloading of a software component through the communication link to the spa controller. While it could be argued that the specification does show this feature, it is clear that there is no defining verbiage to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use this claim element of the invention."

With respect, the Applicant submits that the Examiner may have erroneously applied the test pertaining to the written description requirement rather than the test pertaining to the enablement requirement 35 U.S.C. §112 first paragraph. As indicated in MPEP 2164: "The enablement requirement of 35 U.S.C. 112, first paragraph, is separate and distinct from the description requirement. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) ("the purpose of the 'written description' requirement is broader than to merely explain how to 'make and use'"). See also MPEP § 2161. Therefore, **the fact that an additional limitation to a claim may lack descriptive support in the disclosure as originally filed does not necessarily mean that the limitation is also not enabled.** In other words, the statement of a new limitation in and of itself may enable one skilled in the art to make and use the claim containing that limitation even though that limitation may not be described in the original disclosure. Consequently, such limitations must be analyzed for both enablement and description using their separate and distinct criteria." [our emphasis]

The applicant submits that in the previous sections of the present response the Applicant has overcome the issue of whether the written description requirement of 35 U.S.C. §112 first paragraph was satisfied by the above claims. As such, the applicant will address the Examiner's rejection regarding the enablement requirement herein below.

With reference to MPEP 2164.01, the Applicant submits that the standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable?. Stated otherwise, the test of enablement is whether one reasonably skilled in the art could make or use

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.

The applicant submits that the specification as originally filed provides sufficient information to use the claimed invention. Such support can be found throughout the specification, in particular on pages 9 & 10 of the specification and in claim 29 as originally filed. With reference to 2164.01(c), if a statement of utility in the specification contains within it a connotation of how to use, and/or the art recognizes that standard modes of administration are known and contemplated, 35 U.S.C. 112 is satisfied. *In re Johnson*, 282 F.2d 370, 373, 127 USPQ 216, 219 (CCPA 1960); *In re Hitchings*, 342 F.2d 80, 87, 144 USPQ 637, 643 (CCPA 1965). See also *In re Brana*, 51 F.2d 1560, 1566, 34 USPQ2d 1437, 1441 (Fed. Cir. 1993).

The applicant also submits that the specification as originally filed provides sufficient information to make the claimed invention. Such support can be found throughout the specification, in particular on pages 9 & 10 of the specification, in claim 29 as originally filed as well as on pages 4, 5, 6, 11, 12, 13 and in the figures. With reference to MPEP 2164.01(b), as long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

Finally, the applicant submits that one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.

In light of the above, the applicant submits that claims 155, 158-172, 180-183, 185, 186 and 195-219, satisfy the enablement requirement of 35 U.S.C. §112 first paragraph. As such, the Applicant respectfully requests that the Examiner withdraw his rejection of these claims under of 35 U.S.C. §112 first paragraph with respect to the enablement requirement.



Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

Claims 187 and 190-194

With respect to independent claims 187 and 190-194, the Examiner rejected these claims as failing to satisfy the enablement requirement of 35 U.S.C. §112 first paragraph. More specifically, the Examiner indicates that the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As above, in support for his position, the Examiner refers to his previously presented argument regarding the written description requirement and indicates that: "As noted above, these claims contain subject matter that is merely alluded to in the specification with no specific examples or instructions for one of ordinary skill."

As above, the Applicant respectfully submits that the Examiner may have erroneously applied the test pertaining to the written description requirement rather than the test pertaining to the enablement requirement 35 U.S.C. §112 first paragraph. **The fact that an additional limitation to a claim may lack descriptive support in the disclosure as originally filed does not necessarily mean that the limitation is also not enabled.**

The applicant submits that in the previous sections of the present response the Applicant has overcome the issue of whether the written description requirement of 35 U.S.C. §112 first paragraph was satisfied by the above claims. As such, the applicant will address the Examiner's rejection regarding the enablement requirement herein below.

The applicant submits that the specification as originally filed provides sufficient information to use the claimed invention. Such support can be found throughout the specification, in particular on page p. 10 lines 3-6 of the specification. With reference to 2164.01(c), if a statement of utility in the specification contains within it a connotation of how to use, and/or the art recognizes that

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

standard modes of administration are known and contemplated, 35 U.S.C. 112 is satisfied. *In re Johnson*, 282 F.2d 370, 373, 127 USPQ 216, 219 (CCPA 1960); *In re Hitchings*, 342 F.2d 80, 87, 144 USPQ 637, 643 (CCPA 1965). See also *In re Brana*, 51 F.2d 1560, 1566, 34 USPQ2d 1437, 1441 (Fed. Cir. 1993).

The applicant also submits that the specification as originally filed provides sufficient information to make the claimed invention. Such support can be found throughout the specification, in particular on page p. 10 lines 3-6. With reference to MPEP 2164.01(b), as long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

Finally, the applicant submits that one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.

In light of the above, the applicant submits that claims 187 and 190-194, satisfy enablement requirement of 35 U.S.C. §112 first paragraph. As such, the Applicant respectfully requests that the Examiner withdraw his rejection of these claims under of 35 U.S.C. §112 first paragraph with respect to the enablement requirement.

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

#### **E. Claim Rejection under 35 USC §102/103**

In the Office Action, the Examiner has rejected claims 155, 160-163, 168-172, 180-183, 185, 186, 195-200, 203-206 under 35 U.S.C. §102(e) as being anticipated by U.S. patent Publication 2001/0034754 (hereinafter referred to as Elwahab et al.), or alternatively, under 35 U.S.C. §103(a) as being obvious in light of Elwahab et al. The Examiner further states that if the Applicant contends that the rejected claims are indeed claiming specific spa control rather than a generic controller as viewed by the Examiner, this rejection should be viewed as a 35 U.S.C. 103 rejection in view of Bassett as shown below with reference to claims 187 and 190-194.

#### **F. Reply to Rejection under 35 USC §102 & 103**

Prior to addressing the examiner's arguments, the Applicant would like to bring the following to the Examiner's attention:

Elwahab et al. was cited as a 102(e) reference. The relevant section of 35 USC §102 (e) reads as follows:

“ the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States *before the invention by the applicant for patent* [...]” *[our emphasis]*

The publication date of Elwahab et al. is October 25, 2001 and the filing date of application number 09/759,861 is January 12, 2001. The effective filing date of the Elwahab et al. publication is the filing date of the provisional patent application 60/190,229, namely March 17, 2000, but only insofar as the subject matter is disclosed and supported by the text of provisional patent application 60/190,229. Since the filing date of the present patent application is November 7, 2000, an invention date occurring at least as early as November 7, 2000 can be established. As such, only the subject matter of the Elwahab et al. publication disclosed in provisional patent application 60/190,229 filed March 17, 2000 can be used in support of an

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

anticipation rejection under 35 USC §102 (e) and/or an obviousness rejection under 35 USC §103.

Claim 155

Independent claim 155 reads as follows:

Claim 155. A spa control system, comprising:

A) *a spa controller,*

B) a interface signal converter, in communication with said spa controller. said interface signal converter being operative for:

- establishing a communications link with a remote computer;
- *receiving communication signals conveying software components over the communications link, said software components comprising updates to software already installed on said spa controller;*
- *communicating said software components to said spa controller;*

wherein said interface signal converter converts communication signals received from the remote computer via said communications link and directs the converted signals to said spa controller, and wherein said interface signal converter converts signals from said spa controller to be communicated to the remote computer via said communications link.

The Applicant submits that the subject matter of claim 155, is neither anticipated nor rendered obvious by Elwahab et al.. Without limiting the generality of the foregoing, the applicant submits that the above-emphasized limitations of claim 155 are neither taught nor suggested by Elwahab et al..

Firstly, the applicant submits that Elwahab et al. does not include "a spa controller". This element does not appear anywhere in Elwahab et al. As indicated in section "B. General Comments" above, the Applicant respectfully disagrees with the Examiner's position regarding the interpretation of the spa controller as a generic controller. The Applicant submits that the Examiner interpretation "spa control system" as a "generic control system" is not appropriate since it arbitrarily reads out a claim limitation. . As such, as requested by the Examiner, the applicant will address the present rejection as a rejection under 35 U.S.C. 103 in view of Bassett below.

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

Secondly, the applicant submits that Elwahab et al. does not teach or suggest an interface signal converter [...] operative for:

- [...]
- *receiving communication signals conveying software components over the communications link, said software components comprising updates to software already installed on said spa controller;*
- *communicating said software components to said spa controller;*

In his arguments, the Examiner argues that the above features are present in Elwahab et al. and are described in paragraph [0072] of U.S. patent Publication 2001/0034754. This paragraph is reproduced below:

[0072] Service providers having access to a smart device Markup-Language-type page 32 may be able to remotely control the smart device. For example, a security company may be able to monitor a premise security system and turn on or off various security devices. In addition, a manufacturer of the smart device may be able to automatically push new software upgrades to the smart device.

As indicated above, only the subject matter of U.S. patent Publication 2001/0034754 disclosed in provisional patent application 60/190,229 filed March 17, 2000 can be used in support of an anticipation rejection under 35 USC §102 (e) or an obviousness rejection under 35 USC §103. The above subject matter does not appear in provisional patent application 60/190,229. The applicant submits that there is nothing in provisional patent application 60/190,229 that teaches or suggests the above-emphasized limitations. If the Examiner disagrees with the Applicant, he is respectfully requested to identify in provisional patent application 60/190,229 the above emphasized features. Otherwise, the Examiner is requested to withdraw his rejection under 102(e). The applicant further submits that there is nothing in provisional patent application 60/190,229 to render obvious the above emphasized feature nor to suggest modifying the reference in such a way as to read on the claimed invention. As such, the Examiner is requested to withdraw his rejection under 35 USC §103.

Finally, the feature: an interface signal converter [...] operative for:

- [...]
- *receiving communication signals conveying software components over the communications link, said software components comprising updates to software already installed on said spa controller;*

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

- *communicating said software components to said spa controller;*

is neither taught nor suggested by Bassett. Therefore, a prima facie case of obviousness cannot be made for this claim with the combination of Elwahab et al. and Bassett since not all claim limitations are taught.

In light of the above, the applicant submits that the subject matter of claim 155 is neither anticipated nor rendered obvious by Elwahab et al., alone or in combination with the other cited documents.

**Claims 160-163, 168-172, 180-183 and 185**

Claims 160-163, 168-172, 180-183 and 185 depend directly or indirectly from claim 155 and as such incorporate by reference all its limitations. Since the subject matter of claim 155 was shown to be novel and non-obvious in light of Elwahab et al., the applicant also submits that the subject matter of claims 160-163, 168-172, 180-183 and 185 is also novel and non-obvious in light of Elwahab et al. alone or in combination with the other cited documents.

**Claim 186**

Claim 186 reads as follows:

*Claim 186. A spa control system, comprising:*

*A) a spa controller means,*

*B) an interface signal converter means, in communication with said spa controller means, said interface signal converter means being operative for:*

- *establishing a communications link with a remote computer;*
- *receiving communication signals conveying software components over the communications link, said software components comprising updates to software already installed on said spa controller means;*
- *communicating said software components to said spa controller means;*

*wherein said interface signal converter means converts communication signals received from the remote computer means via said communications link, and wherein said interface signal converter means converts signals from said spa controller means to be communicated to said remote computer means via the communications link.*

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

The Applicant submits that the subject matter of claim 186, is neither anticipated nor rendered obvious by Elwahab et al.. Without limiting the generality of the foregoing, the applicant submits that, for the same reasons as those set forth with respect to claim 155, the above emphasized limitations of claim 186 are neither taught nor suggested by Elwahab et al. alone or in combination with Bassett.

In light of the above, the applicant submits that the subject matter of claim 186 is neither anticipated nor rendered obvious by Elwahab et al., alone or in combination with the other cited documents.

**Claim 195**

Claim 195 reads as follows:

*Claim 195. (Previously presented) A spa control system comprising:*

- A) a spa controller,*
- B) an interface signal converter in communication with said spa controller, said interface signal converter being operative for exchanging signals with a hand-portable remote computer over a wireless communications link, wherein the signals include software components comprising updates to software already installed on said spa controller.*

The Applicant submits that the subject matter of claim 195, is neither anticipated nor rendered obvious by Elwahab et al.. Without limiting the generality of the foregoing, the applicant submits that the above emphasized limitations of claim 195 are neither taught nor suggested by Elwahab et al. alone or in combination with any of the other cited documents.

Firstly, the applicant submits that Elwahab et al. does not include "a spa controller". This element does not appear anywhere in Elwahab et al. As indicated in section "B. General Comments" above, the Applicant respectfully disagrees with the Examiner's position regarding the interpretation of the spa controller as a generic controller. The Applicant submits that the Examiner interpretation "spa control system" as a "generic control system" is not appropriate since it arbitrarily reads out a claim limitation. As such, as requested by the Examiner, the

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

applicant will address the present rejection as a rejection under 35 U.S.C. 103 in view of Bassett below.

Secondly, the applicant submits that Elwahab et al. does not teach or suggest a spa control system including *an interface signal converter [...] operative for exchanging signals with a hand-portable remote computer over a wireless communications link, wherein the signals include software components comprising updates to software already installed on said spa controller.*

In his arguments, the Examiner refers to the arguments presented with respect to claim 155, which relied upon paragraph [0072] of U.S. patent Publication 2001/0034754. As indicated above, only the subject matter of U.S. patent Publication 2001/0034754 disclosed in provisional patent application 60/190,229 filed March 17, 2000 can be used in support of an anticipation rejection under 35 USC §102 (e) or in support of an obviousness rejection under 35 USC §103. The subject matter of paragraph [0072] of U.S. patent Publication 2001/0034754 does not appear in provisional patent application 60/190,229. The applicant submits that there is nothing in provisional patent application 60/190,229 that teaches or suggests the above-emphasized limitations. If the Examiner disagrees with the Applicant, he is respectfully requested to identify in provisional patent application 60/190,229 the above emphasized features. Otherwise, the Examiner is requested to withdraw his rejections under 102(e). The applicant further submits that there is nothing in provisional patent application 60/190,229 to render obvious the above emphasized feature nor to suggest modifying the reference in such a way as to read on the claimed invention. As such, the Examiner is requested to withdraw his rejection under 35 USC §103.

Finally, the feature “a spa control system including an interface signal converter [...] operative for exchanging signals with a hand-portable remote computer over a wireless communications link, **wherein the signals include software components comprising updates to software already installed on said spa controller.**” is neither taught nor suggested by Bassett. Therefore,



Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

a prima facie case of obviousness cannot be made for this claim with the combination of Elwahab et al. and Bassett since not all claim limitations are taught.

In light of the above, the applicant submits that the subject matter of claim 155 is neither anticipated nor rendered obvious by Elwahab et al., alone or in combination with the other cited documents.

**Claims 196-199**

Claims 196-199 depend directly or indirectly from claim 195 and as such incorporate by reference all its limitations. Since the subject matter of claim 195 was shown to be novel and non-obvious in light of Elwahab et al., the applicant also submits that the subject matter of claims 196-199 is also novel and non-obvious in light of Elwahab et al.

With respect to claim 199, the Applicant notes with thanks the Examiner's comments regarding the trademark PALM PILOT<sup>TM</sup>. This term has been replaced by the more generic term PDA device. Support for this term can be found in the application as originally filed. For example, see p. 4 of the specification, second paragraph.

**Claim 200**

Independent claim 200 reads as follows:

*Claim 200. A spa control system comprising:*

- A) a interface signal converter;*
- B) a spa controller in communication with said interface signal converter, said spa controller being adapted for controlling a set of spa components at least in part on the basis of software installed on said spa controller;*
- C) said interface signal converter being operative for:*
  - establishing a communications link with a remote computer;*
  - receiving information conveying software components over the communications link;*
  - transmitting signals conveying the software components to the spa controller;*

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

**D) said spa controller being operative for:**

- *receiving signals conveying the software components from said interface signal converter;*
- *updating software already installed on said spa controller at least in part on the basis of the software components received from interface signal converter.*

The Applicant submits that the subject matter of claim 200, is neither anticipated nor rendered obvious by Elwahab et al.. Without limiting the generality of the foregoing, the applicant submits that the above emphasized limitations of claim 200 are neither taught nor suggested by Elwahab et al. alone or in combination with the other cited documents.

Firstly, the applicant submits that Elwahab et al. does not include "a spa controller". This element does not appear anywhere in Elwahab et al. As indicated in section "B. General Comments" above, the Applicant respectfully disagrees with the Examiner's position regarding the interpretation of the spa controller as a generic controller. The Applicant submits that the Examiner interpretation "spa control system" as a "generic control system" is not appropriate since it arbitrarily reads out a claim limitation. Furthermore, claim 200 sets out that the spa is "in communication with said interface signal converter, said spa controller being adapted for controlling a set of spa components at least in part on the basis of software installed on said spa controller;". Therefore, the Applicant submits that the Examiner's comments on p. 7 of the Office Action indicating that there are no claim elements which set forth the control of the spa do not apply to claim 200.

Secondly, the applicant submits that Elwahab et al. does not teach or suggest spa control system including an interface signal converter and a spa controller where:

- *said interface signal converter being operative for:*
  - *establishing a communications link with a remote computer;*
  - *receiving information conveying software components over the communications link;*
  - *transmitting signals conveying the software components to the spa controller;*
- *said spa controller being operative for:*
  - *receiving signals conveying the software components from said interface signal converter;*

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

- *updating software already installed on said spa controller at least in part on the basis of the software components received from interface signal converter.*

In his arguments, the Examiner refers to the arguments presented with respect to claim 155, which relied upon paragraph [0072] of U.S. patent Publication 2001/0034754. As indicated above, only the subject matter of U.S. patent Publication 2001/0034754 disclosed in provisional patent application 60/190,229 filed March 17, 2000 can be used in support of an anticipation rejection under 35 USC §102 (e) or an obviousness rejection under USC §103. The subject matter of paragraph [0072] of U.S. patent Publication 2001/0034754 does not appear in provisional patent application 60/190,229. The applicant submits that there is nothing in provisional patent application 60/190,229 that teaches or suggests the above-emphasized limitations. If the Examiner disagrees with the Applicant, he is respectfully requested to identify in provisional patent application 60/190,229 the above emphasized features. Otherwise, the Examiner is requested to withdraw his rejection under 102(e). The applicant further submits that there is nothing in provisional patent application 60/190,229 to render obvious the above emphasized feature nor to suggest modifying the reference in such a way as to read on the claimed invention. As such, the Examiner is requested to withdraw his rejection under USC §103.

Finally, the feature "spa control system including an interface signal converter and a spa controller where:

- *said interface signal converter being operative for:*
  - *establishing a communications link with a remote computer;*
  - *receiving information conveying software components over the communications link;*
  - *transmitting signals conveying the software components to the spa controller;*
- *said spa controller being operative for:*
  - *receiving signals conveying the software components from said interface signal converter;*
  - *updating software already installed on said spa controller at least in part on the basis of the software components received from interface signal converter."*

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

is neither taught nor suggested by Bassett. Therefore, a prima facie case of obviousness cannot be made for this claim with the combination of Elwahab et al. and Bassett since not all claim limitations are taught.

In light of the above, the applicant submits that the subject matter of claim 200 is neither anticipated nor rendered obvious by Elwahab et al., alone or in combination with the other cited documents.

**Claims 203-206 and 210-215**

Claims 203-206 and 210-215 depend directly or indirectly from claim 200 and as such incorporate by reference all its limitations. Since the subject matter of claim 200 was shown to be novel and non-obvious in light of Elwahab et al., the applicant also submits that the subject matter of claims 203-206 and 210-215 is also novel and non-obvious in light of Elwahab et al. alone or in combination with the other cited documents.

**Claim 216**

Independent claim 216 reads as follows:

*Claim 216. A computer readable storage medium including a program element suitable for execution by a computing apparatus for implementing a system for monitoring a spa controller, the computing apparatus including a memory unit and processor operatively connection to the memory unit, said program element when executing on said processor being operative for:*

- a) establishing a communications link with a spa controller;*
- b) transmitting information conveying software components over the communications link, the software components being adapted to cause software already installed on the spa controller to be updated.*

The Applicant submits that the subject matter of claim 216, is neither anticipated nor rendered obvious by Elwahab et al.. Without limiting the generality of the foregoing, the applicant

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

submits that, for the same reasons as those set forth with respect to claim 155, the above emphasized limitations of claim 216 are neither taught nor suggested by Elwahab et al. alone or in combination with the other cited documents.

In light of the above, the applicant submits that the subject matter of claim 155 is neither anticipated nor rendered obvious by Elwahab et al., alone or in combination with the other cited documents.

**Claims 217-219**

Claims 217-219 depend directly or indirectly from claim 216 and as such incorporate by reference all its limitations. Since the subject matter of claim 216 was shown to be novel and non-obvious in light of Elwahab et al., the applicant also submits that the subject matter of claims 217-219 is also novel and non-obvious in light of Elwahab et al., alone or in combination with the other cited documents.

**G. Claim Rejection under 35 USC §103(a) - 158, 159, 168, 169, 190, 201 and 202**

In the Office Action, the Examiner has rejected claims 158, 159, 168, 169, 190, 201 and 202 under 35 U.S.C. §103(a) as being unpatentable over Elwahab et al. in view of U.S. Patent No. 5,877,957 (hereinafter referred to as Bennett).

Claims 158, 159, 168 and 169 depend directly or indirectly from claim 155 and as such incorporate by reference all its limitations. Since claim 155 has been shown to be novel and non-obvious in light of the cited documents, the applicant submits that claims 158, 159, 168 and 169 are also novel and non-obvious in light of the cited documents.

Claim 190 depends directly or indirectly from claim 187 and as such incorporates by reference all its limitations. Since claim 187 has been shown to be novel and non-obvious in light of the cited

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

documents, the applicant submits that claim 190 is also novel and non-obvious in light of the cited documents.

Claims 201 and 202 depend directly or indirectly from claim 200 and as such incorporate by reference all its limitations. Since claim 200 has been shown to be novel and non-obvious in light of the cited documents, the applicant submits that claims 201 and 202 are also novel and non-obvious in light of the cited documents.

#### **H. Claim Rejection under 35 USC §103(a) – 164-167 and 207-209**

In the Office Action, the Examiner has rejected claims 164-167 and 207-209 under 35 U.S.C. §103(a) as being unpatentable over Elwahab et al. in view of U.S. Patent No. 6,459,959 (hereinafter referred to as Williams et al.).

Claims 164-167 depend directly or indirectly from claim 155 and as such incorporate by reference all its limitations. Since claim 155 has been shown to be novel and non-obvious in light of the cited documents, the applicant submits that claims 164-167 are also novel and non-obvious in light of the cited documents.

Claims 207-209 depend directly or indirectly from claim 200 and as such incorporate by reference all its limitations. Since claim 200 has been shown to be novel and non-obvious in light of the cited documents, the applicant submits that claims 207-209 are also novel and non-obvious in light of the cited documents.

#### **I. Claim Rejection under 35 USC §103(a) – 187 and 190-194**

In the Office Action, the Examiner has rejected claims 187 and 190-194 under 35 U.S.C. §103(a) as being unpatentable over Elwahab et al. in view of U.S. Patent No. 5,706,191 (hereinafter referred to as Bassett et al.).

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

As will be argued in detail below, the Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness against claim 187 on at least one count.

As per §2142 of the MPEP, in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. And finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

With respect to claim 187 the Applicant respectfully disagrees with the Examiner's rejection on the basis that the Examiner has failed to establish a *prima facie* case of obviousness on the basis that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

The applicant respectfully submits that the person skilled in the art would not have considered the teachings of Elwahab et al. in view of Bassett et al. to arrive to the claimed invention and that there is no suggestion or motivation to modify the reference or to combine reference teachings. As such, the combination of Elwahab et al. in view of Bassett et al. is not sufficient to establish a *prima facie* case of obviousness.

***1) The purpose of the cited references is different from the purpose of the claimed invention***

The Applicant respectfully submits that the purpose of the claimed invention 187 is to provide a spa control system comprising an interface signal converter operative for establishing a communications link with a remote computer and receiving data *comprising a record of errors*

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

*from said spa controller and for transmitting a signal conveying the record of errors to remote computer over said communications link.*

In contrast, the purpose of the *Basset et al.* reference is to provide a system for "connecting appliances, [...] in controlling relationships with one another, and with a central control device, [...], in order to enable all such appliances and systems in a residence or other occupied space to operate in a centrally controlled manner." (see column 1, lines 10-23).

The Examiner's attention is respectfully directed to the case of *In re Clay* (966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992)), which states that "the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve... If [a reference] is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it."

The Applicant respectfully submits that given that the purpose of the present invention is completely different from the purpose of *Basset et al.*, as per *In re Clay*, an inventor would not have had any motivation or occasion to consider this reference.

Therefore, since there is no motivation or suggestion to consider *Basset et al.*, the Applicant respectfully submits that the combination of *Basset et al.* with Britt, Jr. et al. does not support a *prima facie* case of obviousness.

**2) The references cited relate to non-analogous fields of art**

The present application is directed to the field of spas and to devices for controlling spas. The applicant would like to point out that none of the documents relied upon by the examiner in rejecting the claims relate to this technical field.



Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

The Examiner's attention is directed to section 2141.01(a) of the MPEP, which states that to rely on a reference under 35 U.S.C. 103, it must be analogous prior art. It is also stated that the examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Bassett et al. is not in the field of applicant's endeavor, namely that of spa controllers. Bassett et al. pertains to the field of automation systems for connecting devices within a home. The only relationship this reference has with the field of spa is that one of the appliances interconnected with the home automation systems could be "spa pool heater".

Elwahab et al. also pertains to the field of automation systems for connecting devices within a home. The Examiner appears to agree with the above since he states on p. 11 of the Office Action (item 4) that "Bassett shows an automated residence system similar to that of Elwahab [...]".

Although Elwahab et al. and Bassett could arguably be considered to be in analogous fields of art, neither one of them pertains to a field which is analogous to that of the claimed invention. The Applicant respectfully submits that home automation systems are not within the same field of endeavor as spa control systems, and as such would not have been known to a person skilled in the spa control systems. Moreover, a person working in the field of spa control systems and seeking to solve a problem associated with spa control systems should not reasonably be expected to look to the field of home automation systems, in which the Examiner found the Bassett et al. and Elwahab et al. references, to find a solution to his or her problem.

As such, the applicant submits that neither Bassett et al. nor Elwahab et al. can be considered to establish a prima facie case of obviousness under 35 U.S.C. 103.

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

Therefore, the applicant submits that there is no motivation or suggestion to consider Bassett et al. or Elwahab et al. alone or in combination, and as such submits that a *prima facie* case of obviousness is not supported.

In light of the above, the Applicant respectfully submits that there is no suggestion or motivation to combine the reference teachings, and that as such, the combination of these references is insufficient to present a *prima facie* case of obviousness.

In light of the above, the Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness on the basis that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and as such fails to support a rejection based on obviousness, the Applicant respectfully requests that the Examiner withdraw his rejection of claim 187.

Claims 190-194 depend directly or indirectly from claim 187 and as such incorporate by reference all its limitations. Since claim 187 has been shown to be novel and non-obvious in light of the cited documents, the applicant submits that claims 190-194 are also novel and non-obvious in light of the cited documents.

The Applicant has noted the Examiner's comments at on page 12 paragraph 44 of the office action regarding the lack of support for the claim element "record of error". This item was addressed previously in the present response in section "D." above.

Application No. 09/709,787  
Reply to Office Action mailed September 19, 2005

PATENT  
Attorney Docket No. 89003-6

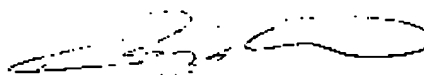
### CONCLUSION

It is respectfully submitted that claims 155, 158-172, 180-183, 185-187, 190-199 and 200-219 are in condition for allowance. Reconsideration of the rejections and objections is requested. Allowance of claims 155, 158-172, 180-183, 185-187, 190-199 and 200-219 at an early date is solicited.

If the claims of the application are not considered to be in full condition for allowance, for any reason, the Applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims or in making constructive suggestions so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,

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